

## **REMARKS**

### **I. Status of the Claims**

Claims 35-63 and 65-84 are pending. No claims have been amended herein. Accordingly, there is no issue of new matter or written description.

Claims 35-37, 40-42, 44-63, and 65-78 were rejected in the Final Office Action. However, it is unclear whether claims 52-61 are withdrawn as previously indicated in the Office Action dated April 23, 2009 at page 3. Applicant respectfully acknowledges the Office's for withdrawal of the species election requirement in regards to the semi-crystalline polymer. See Final Office Action at 2. Accordingly, Applicant assumes that claims 52-61 are no longer withdrawn.

### **II. Claim Rejections - 35 U.S.C. § 103**

#### **A. Claims 35-37, 40-42, 44-63, 65-76 and 78**

Claims 35-37, 40-42, 44-63, 65-76 and 78 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tournilhac (EP 1034776 A1) in view of Stewart (U.S. 5,156,911) for reasons set forth at pages 4-10 of the Office Action. Specifically, the Office contends that Tournilhac "teaches a makeup composition comprising a liquid fatty phase having an effective amount of semi-crystalline olefin copolymer . . . a pigment . . . [and] where the liquid fatty phase is dispersed in a volatile oil such as isododecane." *Id.* at 4 (citations omitted). The Office further contends that "Tournilhac teaches that the copolymers have melting point lower than 150° Celsius . . . [and] teaches the use of these copolymers in combination" *Id.* (citations omitted).

The Office admits that Tournilhac "does not appear to explicitly teach the use of a low melting point polymer in combination with the high melting point polymer." *Id.* The

Office relies on Stewart for teaching a polymer having a melting point within the range of 20-35° Celsius. The Office then concludes that “[i]t would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Tournilhac with the polymer taught by Stewart.” *Id.* at 4-5. Applicant respectfully disagrees and traverses.

The Supreme Court in *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), recognized that a showing of “teaching, suggestion, or motivation” could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). *Id.* at 418. It also explained that rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See id.* at 418. It is important to note that the prior art references relied upon in a rejection “must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. § 2141.02 (VI); *see also Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

Here, the Office has failed to provide sufficient reasons why one of ordinary skill in the art would combine the polymers of Tournilhac with the polymers of Stewart. As discussed above, the Office relies on Tournilhac for the teaching of a makeup composition comprising a liquid fatty phase having an effective amount of a semi-crystalline olefin copolymer, a pigment, where the liquid fatty phase is dispersed in a volatile oil such as isododecane. The Office also relies on Tournilhac for the teaching of polymers having a melting point lower than 150 degrees Celsius, preferably lower than or equal to 110 degrees Celsius. The Office concedes that Tournilhac “does not appear

to explicitly teach the use of a low melting point polymer in combination with the high melting point copolymer.” Final Office Action at 4.

The Office relies on Stewart for teaching an adhesive composition comprising a polymer having a melting point within the range of 20 to 35 degrees Celsius. The Office then alleges “[i]t would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Tournilhac with the polymer taught by Stewart.” The Office explains that “low melting point polymers have advantageous properties such as improved adhesion to the skin” and this would have been “advantageous to the invention of Tournilhac.” *Id.* at 4-5. Applicant respectfully disagrees and traverses the rejection.

First, reading the prior art references *as a whole*, a person of ordinary skill in the art would recognize that there is no motivation to combine the polymers of Tournilhac with the polymers of Stewart. Tournilhac teaches a polymer with a melting point of 150 degrees Celsius, preferably 110 degrees Celsius. Tournilhac further teaches that the copolymers are preferably solid at the ambient temperature of 25 degrees Celsius. See Tournilhac paragraph [0018]. Stewart, on the other hand, teaches a polymer with a melting point of 20 to 35 degrees Celsius. See Stewart, col. 4, ll. 35-42. Because the polymers of Stewart have a melting point of 20 to 35 degrees Celsius, they are not solid at ambient temperature. Thus, one of ordinary skill in the art would not have been motivated to combine the two references.

Second, Stewart is directed to “temperature-sensitive adhesive assemblies” (see Abstract) that are “initially substantially nontacky.” Stewart, col. 4, ll. 21-34. These adhesive assemblies become aggressively tacky upon application to skin and become

“substantially nontacky upon cooling.” *Id.* The Office alleges that one would have been motivated to combine the low melting point polymer because “Stewart teaches that the low melting point polymers have advantageous properties such as improved adhesion to the skin.” Final Office Action at page 5. The Office, however, fails to address why a person skilled in the art would choose the polymer taught by Stewart that becomes easily removed upon cooling. Applicant respectfully disagrees that a person skilled in the art would use a polymer, such as the one taught by Stewart that loses its ability to bind to skin upon a sudden temperature shift. The results are not predictable. As such, the Stewart’s teachings are incompatible with Tournilhac. Applicant thus respectfully requests the rejection be withdrawn.

**B. Claims 35, 76, and 77**

Claims 35, 76, and 77 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tournilhac (EP 1034776 A1) in view of Stewart (U.S. 5,156,911) in further view of Freund et al. (“Parafin Products: Properties, Technologies, Applications” published in 1998) for reasons as set forth at pages 10-12 of the Office Action. Applicant respectfully disagrees and traverses for the following reasons.

The Office relies on Freund for teaching the hardness of lipstick that can be varied by the inclusion of carnauba wax. Final Office Action at 11. However, as discussed above, neither Tournilhac nor Stewart provides motivation to combine the high-melting-point and low-melting-point polymers. Freund does not discuss combining the high-melting-point and low-melting-point polymers, and thus does not remedy the deficiency. Accordingly, this rejection is in error and should be withdrawn.

### III. Double Patenting Rejection

Claims 35-37, 40-42, 44-51 and 62-78 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly unpatentable over claims 1-53 of U.S. Patent No. 6,949,504 in view of Tournilhac (EP 1034776 A1). See Final Office Action at pages 13-14.

Applicant presently agrees to file an appropriate terminal disclaimer when allowable subject matter is indicated in the pending claims.

### IV. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and time allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully invited to contact Applicant's undersigned counsel at (202) 408-4368.

Please grant any extensions of time required to enter this response and charge any additional fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By: 

Deborah M. Herzfeld  
Reg. No. 52,211 